



PATENT
Attorney Docket No.: 09282.0048-00
SAP Reference No.: 2003P00354 US

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)
Andreas MAU) Group Art Unit: 3694
Application No.: 10/619,748)
Filed: July 15, 2003)
For: REAL-TIME BENEFITS SERVICE) Examiner: Martin A. Gottschalk
MARKETPLACE) Confirmation No.: 7407
)

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Commissioner for Patents
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Sir:

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Applicant requests a pre-appeal brief review of the rejections in the Final Office Action mailed February 9, 2007. This Request is being filed concurrently with a Notice of Appeal, in accordance with the Official Gazette Notice of July 12, 2005.

In the Amendment After Final filed on May 9, 2007, Applicant proposed to incorporate the subject matter of dependent claims 33 and 46 into their respective independent claims 31 and 44. In the Advisory Action mailed May 31, 2007, the Examiner did not enter the proposed claim amendments for purposes of appeal, even though the amendments (1) do not raise new issues requiring further consideration and/or search, (2) do not raise the issue of new matter, and (3) materially reduce and simplify the issues for appeal. While Applicant disagrees with the Examiner's position,

to advance prosecution and this Request, Applicant will separately address the patentability of the independent claims and the dependent claims.

In the Office Action, the Examiner (1) rejected claims 31, 32, 39, and 42 under 35 U.S.C. § 103(a) as being unpatentable over E-Benefits Inc. website ("E-Benefits") in view of U.S. Pub. No. 2002/0049642 to Moderegger et al. ("Moderegger"); (2) rejected claim 33 under § 103(a) as being unpatentable over *E-Benefits* in view of *Moderegger* and U.S. Pub. No. 2002/0023212 to Proudler ("Proudler"); (3) rejected claims 34-36 under § 103(a) as being unpatentable over *E-Benefits* in view of *Moderegger* and MacSweeny, Gregory, "Billing System Drives Cross-Sell Efforts" ("MacSweeny"); (4) rejected claims 37 and 38 under § 103(a) as being unpatentable over *E-Benefits* in view of *Moderegger*, *MacSweeny*, and Singerman, Frederic S., "The Impact of the Electronic Signatures Act on Plan Administration," Journal of Pension Benefits: Issues in Administration ("Singerman"); (5) rejected claims 40 and 41 under § 103(a) as being unpatentable over *E-Benefits* in view of *Moderegger* and U.S. Pub. No. 2003/0229522 to Thompson et al. ("Thompson"); (6) rejected claim 43 under § 103(a) as being unpatentable over *E-Benefits* in view of *Moderegger* and Tomsen, Mai-lan, "Killer Content: Strategies for Web Content and E-Commerce" ("Tomsen"); and (7) rejected claims 44-58 for substantially the same reasons as provided above for claims 31-43.

Applicant respectfully traverses all of the 35 U.S.C. § 103 rejections in the Final Office Action because a *prima facie* case of obviousness has not been established for reasons set forth below.

Rejections of the Independent Claims

Independent claim 31 recites a combination of features including, for example,

"the contract document includes a status of at least one of accepted, rejected, and amended." The Examiner does acknowledge that *E-Benefits* fails to disclose the above-quoted feature of providing a "status" in the "contract document." See Office Action, pp. 4-5. However, the Examiner argues that paragraphs 0036 and 0057 of *Moderegger* suggest the above-quoted features of claim 31. See Office Action, p. 5. This is not correct.

The Examiner apparently considers the "contract" of *Moderegger* to correspond to Applicant's "contract document" recited in claim 31. See Office Action, p. 4. The Examiner further considers *Moderegger's* "awarding of a contract" and the statement that the "contract has been awarded" as a teaching of "a status of . . . accepted," as recited in claim 31. See Office Action, p. 5. Assuming *arguendo* that the Examiner's characterization of *Moderegger* is correct, which Applicant does not concede, *Moderegger* does not teach that "the contract document includes a status," as recited in claim 31 (emphasis added).

Moderegger teaches that "the bid prices . . . that were accepted in the awarding of a contract . . . [are] loaded onto the database." *Moderegger*, para. 0036. Furthermore, the database in *Moderegger* contains a "price description field [which] includes . . . whether the bid was accepted." *Moderegger*, para. 0036. However, *Moderegger* does not teach or suggest that the "status" (e.g., accepted) is included in the "contract document" itself. Therefore, *Moderegger* fails to teach or suggest "the contract document includes a status of at least one of accepted, rejected, and amended," as recited in claim 31 (emphasis added). Accordingly, *E-Benefits* and *Moderegger*, taken alone or in any proper combination, fail to teach or suggest all of the

elements of claim 31. Independent claims 44, 57, and 58, although different in scope from claim 31, distinguish over *E-Benefits* and *Moderegger* for at least reasons similar to those discussed above in claim 31. Therefore, a *prima facie* case of obviousness has not been established with respect to claim 31, 44, 57, and 58.

Rejections of the Dependent Claims

Dependent claim 33 recites “wherein if the received contract document includes the status of rejected, then automatically selecting a next best bid from the received bids based on the sorting, and repeating the automatically transmitting and automatically receiving the contract document steps with the next best bid.” The Examiner argues that *Proudler* teaches the above-quoted features of claim 33. See Office Action, p. 7. Applicant respectfully disagrees.

Although *Proudler* may disclose rejecting a contract, as the Examiner alleges, *Proudler* does not teach or suggest “automatically selecting the next best bid from the received bids,” as recited in claim 33. The Examiner argues that “repeating the automatically transmitting and automatically receiving the contract document steps with the next best bid,” as recited in claim 33, is obvious as duplication of steps in view of *In re Harza*, 274 F.2d 669, 124 USPQ 378 (CCPA 1960). See Office Action, pp. 7-8. However, the Examiner misapplies *In re Harza* to the present claims. First, *In re Harza* applies to duplication of parts, not duplication of functions or steps. Second, the above-quoted recitation of claim 33 is not mere duplication of steps. The first transmitting and receiving steps occur with the best bid. The second (and subsequent) transmitting and receiving steps occur with the next best bid. Accordingly, these steps are distinct and are not mere duplications. Moreover, “automatically selecting the next best bid from the

received bids," is a step that did not occur before and, therefore, is not a repeat or duplication of a previous step.

Therefore, for at least the reasons set forth above, *E-Benefits*, *Moderegger*, and *Proudler*, taken alone or in any proper combination, fail to teach or suggest each and every element of claim 33. Dependent claim 46, although different in scope from claim 33, distinguishes over *E-Benefits*, *Moderegger*, and *Proudler* for at least reasons similar to those discussed above in claim 33. In addition, dependent claims 32, 34-45, and 47-56 are allowable at least by virtue of their dependence from allowable base claims 31 and 44, and because other the cited references, *MacSweeny*, *Singerman*, *Thompson*, and *Tomsen*, fail to cure the above-discussed deficiencies of *E-Benefits* and *Moderegger*. Therefore a *prima facie* case of obviousness has not been established with respect to claims 32-43 and 45-56.

CONCLUSION

In view of the foregoing, Applicant respectfully requests reconsideration of this application and the timely allowance of all pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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By: _____

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Dated: July 9, 2007